

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: James R. Tighe
Serial No.: 10/810,512
Filing Date: March 26, 2004
Group Art Unit: 2476
Confirmation No.: 1184
Examiner: Mounir Moutaquakil
Title: *Supporting Enhanced Media Communications Using a
Packet-Based Communication Link*

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

As of a Final Office Action dated April 1, 2010 ("*Office Action*"), Claims 1-22, 24-26, and 33-39 are pending in the Application and stand rejected. Applicants respectfully request a finding that these rejections are improper on clear legal and factual grounds and request allowance of these claims.

I. Claims 1-8, 10-17, 19, 20, 22, 24-26, and 33-39 are allowable over the proposed combination of *Bales* and *Schroderus*

The *Office Action* rejects Claims 1-8, 10-17, 19, 20, 22, 24-26, and 33-39 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,574,724 to Bales, et al, ("*Bales*") in view of U.S. Patent Publication No. US 2003/0223381 to Schroderus ("*Schroderus*"). Applicants respectfully traverse and submit that the proposed *Bales-Schroderus* combination fails to teach or suggest all elements of the claims.

Consider Applicants' Claim 1, which recites:

A method for supporting communications comprising:
 establishing a packet-based audio communication link
 between a local telephony device and a remote telephony
 device;
 informing a local computing device coupled to the local
 telephony device of the audio communication link;
 receiving a message from the local computing device,
 the message requesting identification of enhanced media
 capabilities associated with a remote computing device coupled
 to the remote telephony device;
 tunneling the message in the audio communication link
 to the remote telephony device;
 receiving a tunneled response in the audio
 communication link from the remote telephony device, the
 response identifying the enhanced media capabilities associated
 with the remote computing device; and
 forwarding the response to the local computing device.

Among other aspects, the cited references do not disclose the claimed configuration of devices including (1) "a local telephony device;" (2) "a remote telephony device;" (3) "a local computing device coupled to the local telephony device;" and (4) "a remote computing device coupled to the remote telephony device." At best, *Bales* appears to disclose the existence of a communication terminal on either end of a call and requesting an adjustment of

bandwidth during that call. *See Bales*, 3:32-60. *Bales*, however, does not teach or suggest the claimed configuration of devices, much less “receiving a message from the local computing device [coupled to the local telephony device] . . . requesting identification of enhanced media capabilities associated with a remote computing device [coupled to the remote telephony device],” as Claim 1 requires. In fact, *Bales*’ disclosure of two communication terminals on either end of a call teaches away from the claimed configuration and technique for identifying enhanced media capabilities. *See Bales*, 3:32-60. Likewise, *Schroderus* fails to disclose these concepts. In light of this clear deficiency, Claim 1 is allowable.

Independent Claims 10, 19, 22, 33, 35, and 39 include limitations that, for substantially similar reasons, are not disclosed by *Bales*. Thus, the proposed combination of *Bales* and *Schroderus* does not teach or suggest every element of independent Claims 1, 10, 35, and 39. Because the rejections are improper on clear legal and factual grounds, Applicants respectfully request the Pre-Appeal Board to instruct the Examiner to issue a Notice of Allowance for all independent claims and their dependents.

II. Claims 9, 18, and 21 are allowable over the proposed combination of *Bales*, *Schroderus*, and *Bowman-Amuah*

The *Office Action* rejects Claims 9, 18, and 21 under 35 U.S.C. § 103(a) as unpatentable over *Bales* in view of *Schroderus* and further in view of U.S. Patent No. 6,434,568 to Bowman-Amuah (“*Bowman-Amuah*”).


For the reasons indicated above, *Bales* fails to disclose, expressly or inherently, every element of independent Claims 1, 10, and 19. *Bowman-Amuah* fails to cure this deficiency. Claims 9, 18, and 21 depend from independent Claims 1, 10, and 19, respectively, and thus are allowable over of the proposed combination of *Bales* and *Bowman-Amuah* for at least the same reason. Because the rejections are improper on clear legal and factual grounds, Applicants respectfully request the Pre-Appeal Board to instruct the Examiner to issue a Notice of Allowance for Claims 9, 18, and 21.

CONCLUSION

As the rejections of Claims 1-22, 24-26, and 33-39 contain clear legal and factual deficiencies, Applicants respectfully request the Pre-Appeal Board to direct the Examiner to issue a Notice of Allowance for these claims. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorney for Applicants

A handwritten signature in black ink, appearing to read 'Kurt M. Pankratz', with a long horizontal stroke extending to the right.

Kurt M. Pankratz
Reg. No. 46,977

Date: June 30, 2010
Customer No. 05073